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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/642,526
Filing Date: August 18, 2000
Appellant(s): DAN ET AL.

MAILED

AUG 19 2004

GROUP 3600

William E. Lewis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 January 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 2144

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 11/21/03 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO 97/29443	O'BRIEN ET AL.	8-1997
5,893,905	MAIN ET AL.	4-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. Claims 1-6, 10-18, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien et al. (WO 97/29443 (as cited in Applicant's IDS)).

(A) As per claim 1, O'Brien discloses an apparatus for use in a computer hosting services environment, the apparatus comprising: at least one processor (O'Brien; page 1, lines 6-13) operative to: (i) construct an electronic service level agreement between a service provider and a client based on client input for an application associated with the client to be hosted by the service provider (O'Brien; page 8, lines 18-29 and page 16, lines 11-21); and (ii) check the consistency of the electronic service level agreement with respect to one or more existing electronic service level agreements previously committed to by the service provider (O'Brien; page 3, lines 18-22 page 6, lines 23-28 and 32-page 7, line 6).

(B) As per claim 2, O'Brien teaches wherein the at least one processor is further operative to modify the electronic service level agreement when at least one inconsistency is found (O'Brien; page 16, line 26-page 17, line 2).

(C) As per claim 3, O'Brien teaches wherein the at least one processor is further

Art Unit: 2144

operative to provision one or more resources of an infrastructure on which the application is to be hosted in accordance with the constructed electronic service level agreement (O'Brien; page 17, lines 11-18).

(D) As per claim 4, O'Brien teaches wherein the at least one processor is further operative to execute the constructed electronic service level agreement (O'Brien; page 17, lines 11-28).

(E) As per claim 5, O'Brien teaches wherein the at least one processor is further operative to report one or more events associated with the execution of the constructed electronic service level agreement (O'Brien; page 17, lines 18-28 and page 30, lines 18-24).

(F) As per claim 6, O'Brien teaches wherein the one or more events comprise at least one of a violation of a portion of the electronic service level agreement and a near-violation of a portion of the electronic service level agreement (O'Brien; page 7, line 30-page 8, line 4).

(G) As per claim 10, O'Brien teaches wherein the at least one processor is further operative to determine whether the electronic service level agreement will be satisfied for a given workload based on historical data (O'Brien; page 6, line 32-page 7, line 6).

(H) As per claim 11, O'Brien teaches wherein the at least one processor is further

Art Unit: 2144

operative to determine for how long the electronic service level agreement will be satisfied based on a workload forecasting and performance prediction technique (O'Brien; page 6, line 16-page 7, line 6 and page 16, line 11-page 17, line 18).

(I) As per claim 12, O'Brien teaches wherein the constructing operation comprises determining pricing for inclusion in the electronic service level agreement associated with the hosting of the application by the service provider (O'Brien; page 6, line 16-page 7, line 6 and page 16, line 11-page 17, line 18).

(J) Method claims 13-18 and 22-24 repeat the subject matter of apparatus claims 1-6 and 10-12, respectively, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 1-6 and 10-12 have been shown to be fully disclosed by the teachings of O'Brien in the above rejections of claims 1-6 and 10-12, it is readily apparent that the apparatus disclosed by O'Brien includes the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for apparatus claims 1-6 and 10-12, and incorporated herein.

(K) Claim 25 repeats the features of claim 1 and is therefore rejected for the same reasons given above in the rejection of claim 1 and incorporated herein.

(L) Claim 26 repeats the features of claims 1-4 and is therefore rejected for the same reasons given above in the rejections of claims 1-4 and incorporated herein.

Claim Rejections - 35 USC § 103

2. Claims 7-9 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al. (WO 97/29443) as applied to claims 5 and 17 above and further in view of Main et al. (5,893,905).

(A) As per claims 7 and 8, O'Brien fails to expressly teach wherein the at least one processor is further operative to provide a warning or an alarm that a portion of the electronic service level agreement is one of violated and near-violated. However, this feature is old and well known in the art, as evidenced by Main's teachings with regards to wherein the at least one processor is further operative to provide a warning or an alarm that a portion of the electronic service level agreement is one of violated and near-violated (Main; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by O'Brien with Main's teaching with regards to this limitation, with the motivation of alerting service requestor of the potential impact of SLA violation (Main; abstract).

(B) As per claim 9, O'Brien fails to expressly teach wherein the at least one processor is further operative to provide an explanation as to why a portion of the electronic service level agreement is one of violated and near-violated. However, this feature is old and well known in the art, as evidenced by Main's teachings with regards to wherein the at least one processor is further operative to provide an explanation as to why a portion of the electronic service level agreement is one of violated and near-violated

Art Unit: 2144

(Main; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by O'Brien with Main's teaching with regards to this limitation, with the motivation of alerting service requestor of the potential impact of SLA violation (Main; abstract).

(C) Method claims 19-21 repeat the subject matter of apparatus claims 7-9, respectively, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 7-9 have been shown to be fully disclosed by the teachings of O'Brien and Main in the above rejections of claims 7-9, it is readily apparent that the apparatus disclosed by O'Brien and Main includes the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for apparatus claims 7-9, and incorporated herein.

(11) Response to Argument

(A) On pages 4-5 of Appellant's brief, Appellant argued that the present invention provides a system in which the consistency of a proposed SLA is checked with respect to one or more existing SLAs that were committed to by the service provider, while decisions to provide service in O'Brien are based on estimated stored parameters of past resource performance, in reference to claims 1-6, 10-18, and 22-26.

In response, it is respectfully noted by the Examiner that O'Brien's stored parameters of past resource performance are based on one or more existing SLAs that were committed to by the service provider. In particular on page 6, lines 23-27 of O'Brien, it clearly states that the stored parameters might include the average time a

Art Unit: 2144

service is expected to take, the expected cost of performing tasks to provide a service and/or **the amount of work already being done by the system**. It is clear in O'Brien that the amount of work already being done by the system is based on one or more existing SLAs that were committed by the service provider. Specifically at col. 6, line 28-col. 7, line 6, O'Brien teaches that the processing means is typically adapted to receive data from a resource(s) for use in updating the data store. Such data might comprise a measure of capability of the system on the basis of the past performance of the resources. For example, **each time a service has been provided**, information about how well the resources performed may be used to adjust the parameter(s). Performance information might include **actual cost data** and **actual time taken** to provide a required output. The information might also include task **current status information** which is readily available to the system. Furthermore at col. 18, line 22-col. 19, line 3 of O'Brien, an example of an SLA is given which clearly indicates that data such as actual cost data and actual time taken are based on one or more existing SLAs committed to by the service provider (i.e., the amount of work already being done by the system). Therefore it is respectfully submitted that a system that checks the consistency of a proposed SLA against stored parameters that are based on one or more existing SLAs that were committed to by the service provider clearly reads on a system in which the consistency of a proposed SLA is checked with respect to one or more existing SLAs that were committed to by the service provider.

Art Unit: 2144

(B) On page 5 of Appellant's brief, Appellant argued that O'Brien could not allow for reconstruction of an SLA after checking consistencies with actual existing SLAs, and before allocation of system resources, in reference to claims 1-6, 10-18, and 22-26.

In response, it is noted that the features upon which applicant relies (i.e., reconstruction of an SLA after checking consistencies with actual existing SLAs, and before allocation of system resources) are not recited in the rejected claim (s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 998 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993).

Further, even if such limitations were inserted in the claim, O'Brien does teach allowing modifications to a proposed SLA after checking for consistency with one or more existing SLAs that were committed to by the service provider and before allocation of system resources (O'Brien; page 3, lines 23-32 and page 16, line 11-page 17, line 10).

(C) On page 6 of Appellant's brief, Appellant argued that O'Brien fails to teach a modifying the electronic service level agreement when at least one inconsistency is found, provisioning module which provides one or more resources of an infrastructure on which the application is to be hosted in accordance with the constricted electronic service level agreement and execution system which executes the constructed service level agreement, in reference to claim 26.

In response, the Examiner is concerned that, aside from merely alleging that certain claimed features are not anticipated by O'Brien essentially in the form of blanket statements, Appellant does not point to any specific distinction(s) between the features

Art Unit: 2144

disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section."

Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

The Examiner maintains that O'Brien teaches all such features. O'Brien teaches modifying the electronic service level agreement when at least one inconsistency is found (O'Brien; page 2, lines 8-31, page 16, line 26-page 17, line 2, and page 28, lines 21-25). O'Brien teaches provisioning module which provides one or more resources of an infrastructure on which the application is to be hosted in accordance with the constructed electronic service level agreement (O'Brien; page 16, line 16 and page 17, lines 11-18). Finally, O'Brien teaches execution system that executes the constructed electronic service level agreement (O'Brien; page 5, lines 3-9 and page 17, lines 11-28).

(D) On page 7 of Appellant's brief, Appellant argued that no motivation or suggestion exists to combine O'Brien and Main in a manner proposed by the Examiner, in reference to claims 7-9 and 19-21.

In response, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be

Art Unit: 2144

motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate

Art Unit: 2144

obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(E) On page 8 of Appellant's brief, Appellant argued that Appellants do not believe that O'Brien and Main are combinable since it is not clear how one would combine them, in reference to claims 7-9 and 19-21.

In response, it is respectfully submitted the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In *re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render

Art Unit: 2144

obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

In addition, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s), which specifically support that particular motivation. As such, it is NOT seen that the Examiner’s combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.

In the instant case, the Appellant has failed to provide evidence showing there was no reasonable expectation of success. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”). See MPEP § 716.01(c) for examples of

Art Unit: 2144

attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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